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THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB 8/30/00

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Thrifty, Inc.

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Serial No. 75/193,074

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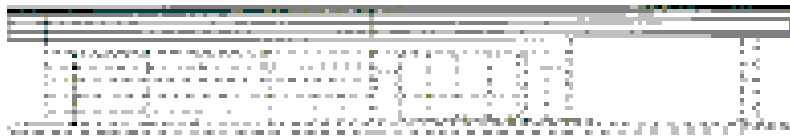
Before Seeherman, Hohein and Holtzman, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Thrifty, Inc., assignee of Thrifty Rent-A-Car System,  
Inc., has appealed from the final refusal of the Senior  
Trademark Attorney to register, pursuant to Section 2(f) of  
the Trademark Act, what it refers to as "the color blue" as

a service mark for automobile, truck and recreational vehicle renting and leasing.<sup>1</sup>

In order to understand the refusals, information about the prosecution of the application is necessary. Applicant's initial application papers depicted the mark on the drawing page as a building. A copy of that mark is shown below. It should be noted that most of the structural features are shown in broken lines, and the upper wall is lined for the color blue.



In the first Office action the Senior Trademark Attorney, inter alia, required that applicant provide a description of the mark, and suggested the following: "The mark consists of the color blue used on buildings. The matter shown in the drawing in broken lines serves only to show positioning of the mark and no claim is made to it." The Trademark Attorney's Office action made it clear that her understanding of applicant's mark was that it was the color blue applied to a specific portion of a building.

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<sup>1</sup> Application Serial No. 75/193,074, filed October 31, 1996, and asserting first use and first use in commerce as of May 8, 1986.

In response to the first Office action, applicant first contacted the Senior Trademark Attorney by telephone and then submitted an amendment in which applicant explained that it was seeking registration for

...the color blue as it is used by applicant in connection with the services identified in the application. Applicant's mark is not limited to the color blue as used on its vehicle rental centers. The building is a "carrier" of the mark, as are Applicant's blue shuttle buses, blue uniforms, blue signs, and other advertising and promotional materials featuring the color blue.

Applicant offered the following description of its mark:

The mark consists of the color blue used in connection with the services set forth in the application. The color blue is used on vehicle rental centers, signs, vehicles, uniforms, and in other advertising and promotional materials to show that the color blue identifies and distinguishes applicant's services.

In the second Office action, mailed March 9, 1998, the Senior Trademark Attorney, inter alia, refused to accept the amended description of the mark because it did not agree with the mark as shown on the drawing and because it described more than one mark. The Trademark Attorney specifically stated that the amendment would expand the mark for which application had been made, and that such an amendment would materially alter the mark as shown in the

drawing. She also said that the application of the color blue in the various ways indicated by applicant resulted in multiple marks because the commercial impression of the mark changes with each application.

Applicant thereupon, on August 26, 1998, filed a new proposed description of the mark:

The mark consists of the solid color blue (Pantone Matching System 300) used in connection with the services set forth in the application. The solid color blue is used on vehicle rental centers, signs, vehicles, uniforms, and in other advertising and promotional materials to show that the solid blue identifies and distinguishes applicant's services.

On January 19, 1999 the Senior Trademark Attorney issued a final Office action, refusing registration pursuant to Sections 1, 2 and 45 because the color blue does not function as a mark for the identified services, and the evidence of acquired distinctiveness submitted by applicant is insufficient to support registration under Section 2(f);<sup>2</sup> and requiring an acceptable description of the mark, stating that applicant's proposed description of its mark is unacceptable because it is so broad that it

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<sup>2</sup> This ground of refusal was raised in the two earlier Office actions as well.

includes more than one mark, and that it does not agree with the mark as it appears on the drawing.

The appeal has been fully briefed, and applicant and the Senior Trademark Attorney appeared at an oral hearing before the Board.

We turn first to a consideration of what is the mark that applicant is seeking to register. As noted above, the mark shown in the drawing is that of a building depicted in broken lines, indicating that no claim is being made to the specific shape of the building, but with the upper wall of the building lined for the color blue. This is the usual method to indicate that the claimed mark is the color blue located on a particular place on a structure. Applicant asserts that the mark it applied for, in its original application papers, was not the color blue used on a building, but the color blue in general. It bases its position on the reference to "Mark: The Color Blue" at the top of the first page of its application; the language in its application that "The above-identified applicant has adopted and is using the color Blue for its service mark..."; the claim of ownership of four registrations for word marks lined for the color blue or having a blue background; and the further statements that:

Applicant seeks registration under 15 U.S.C. § 1052(f) on the basis that the color Blue has become distinctive of the services, as evidenced by Applicant's substantially exclusive and continuous use of that color as a mark in connection with such services.

The mark is used as a service mark by depicting it in promotional literature and advertisements, as well as on signage, canopy facia, vehicles, and displays closely associated with the services, and three (3) specimens showing use of the mark as actually used are presented herewith.

In point of fact, the application states that "The above-identified applicant has adopted and is using the color Blue for its service mark, as shown in the accompanying drawing..." (emphasis added). And, as noted above, the drawing referenced by the application shows the mark as the color blue placed on the top portion of a vehicle service center, with the building itself depicted in broken lines. Further, the specimens submitted with the application show a vehicle service center with the color blue used in the same manner as that on the drawing, i.e., on the upper part of the building.

Although applicant asserts that the mark for which registration is sought 'has always been the solid color blue," reply brief, p. 9, it also acknowledges that there is an ambiguity in its application. Reply brief, p. 11,

12. However, applicant relies on **In re Eccs, Inc.**, 94 F.3d 1578, 39 USPQ2d 2001 (Fed. Cir. 1996), to support its position that the ambiguity should be resolved by allowing applicant to amend the description of its mark. The Eccs decision essentially held that when an original application is internally inconsistent as to what the mark is, one should look to the specimens to determine what an applicant wishes to register, not to "a clearly inconsistent and erroneous drawing made by its attorney." Id. at 39 USPQ2d 2004. We do not believe that there is an internal inconsistency in the present application: A reasonable reading of the original application, including a review of the drawing and the specimens, is that the mark for which registration is sought is the color blue placed in a particular part of a building.

However, our decision as to what applicant's mark is does not turn on whether or not the application has an internal inconsistency. As applicant has noted in its reply brief, subsequent to the Eccs decision the Patent and Trademark Office issued a notice of final rulemaking by which certain of the rules applicable to drawings were amended. The stated purpose for such amendments was "to prohibit amendments that materially alter the mark on the original drawing." 64 Fed. Reg. 48900, 48902 (Sept. 8,

1999). In particular, Trademark Rule 2.52(a) was amended to add the language "A drawing depicts the mark sought to be registered." These amendments to the Trademark Rules became effective on October 30, 1999, and the Notice of Final Rulemaking expressly states that "these rule changes ... shall apply to any application for registration pending on, or filed on or after, October 30, 1999." Because applicant's application was indeed pending on that date, the amended rules apply to applicant's application and govern this proceeding. See **In re Who? Vision Systems, Inc.**, \_\_USPQ2d\_\_, Serial No. 75/399,617 (TTAB Aug. 15, 2000), for an extensive discussion of the amendments to the rules, and their retroactive effect.

In view of the amendments to the Trademark Rules, there is no question that the mark for which application was made is the mark shown in the drawing--the color blue placed on the wall of a building--and not the color blue in general.

Before discussing whether the description of the mark applicant seeks to enter would be a material alteration of the original mark, we must address a complaint by applicant. Applicant had previously filed an application in which it identified its mark as "the color blue" in the application, and indicated "No Drawing" on the drawing



page. This application was not given a filing date because "no trademark appears on the drawing," and the application was returned to applicant as an incomplete application. Applicant tried to remedy the previous failure to provide a drawing by submitting the present application. Applicant asserts that the Office has placed it in a "Catch-22" situation: file an application for the solid color blue without a drawing and be denied a filing date or, alternatively, file an application with a drawing and not be permitted to accurately identify the mark.

We disagree with applicant's assertions. To the extent that applicant has been placed in a "Catch-22" situation, it has placed itself there. If applicant believed that the Office erred in refusing to accord its first application a filing date, its proper remedy was to petition the Commissioner, rather than file a second application which did not properly show the mark for which it actually sought registration.<sup>3</sup>

This brings us to the question of whether applicant's proposed description of its mark, as set forth below, would be a material alteration of the mark shown in the drawing.<sup>4</sup>

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<sup>3</sup> It should be noted that the previous application and the subject application were not filed by applicant's present counsel.

<sup>4</sup> Trademark Rule 2.72(a) provides that "amendments may not be made to the description or drawing of the mark if the character

The mark consists of the solid color blue (Pantone Matching System 300) used in connection with the services set forth in the application. The solid color blue is used on vehicle rental centers, signs, vehicles, uniforms, and in other advertising and promotional materials to show that the solid blue identifies and distinguishes applicant's services

Applicant argues that the mark shown in the drawing is not materially altered by the proposed description because the essential nature of the mark is not changed, i.e., it remains the solid color blue. However, the mark shown in the drawing is not just the color blue, it is the color blue applied to a specific part of a building. It is the placement of the color, and not the color alone, which is shown in the drawing. Because the proposed description describes the mark as the color blue applied to a variety of venues, and not limited to a particular placement on a building, the mark described in this description would be a material alteration of the mark shown in the drawing.

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of the mark is materially altered. The determination of whether a proposed amendment materially alters the character of the mark will be made by comparing the proposed amendment with the description or drawing of the mark as originally filed." We should point out that applicant's original application did not include a description of the mark, as that term is used in the Trademark Rules. See Rule 2.37. Accordingly, as noted above, the mark in the application is the mark in the drawing, and the question before us is whether applicant's proposed description would materially alter the character of that mark.

Much of applicant's and the Senior Trademark Attorney's briefs were devoted to argument about whether applicant's asserted color blue trademark should be considered a single mark, amenable to protection through a single application for registration, as applicant contends, or whether it would convey different commercial impressions depending on the format or venue in which it is used, as the Senior Trademark Attorney claims. In fact, the real issue in this case, as far as applicant and the Trademark Attorney are concerned, is whether applicant may obtain a registration for the color blue per se, not limited to any particular physical format or venue. Therefore, we think it appropriate to address these arguments.

Applicant likens its asserted solid color blue trademark to a word mark, which retains its essential character no matter whether it is used on stationery, brochures, signage, a courtesy bus, etc. However, there are inherent differences between a word mark and a color mark, not the least of which is the fact that a word mark may be inherently distinctive and registrable without a showing of acquired distinctiveness, while a mark consisting of a single color, such as applicant's Pantone No. 300 blue, can only be registered with such a showing. See **Qualitex Co. v. Jacobson Products Co.**, 514 US 159, 131

L.Ed2d 248, 115 S.Ct. 1300, 34 USPQ2d 1161 (1995); **Wal-Mart Stores v. Samara Bros.**, No. 99-150, 146 L.Ed.2d 182, 120 S.Ct. 1339, 54 USPQ2d 1065 (2000). Although a word mark retains its same appearance and commercial impression whether it is used on signage, stationery, etc., the commercial impression of a color changes depending on the object on which it is applied because the color is inextricably bound to the object. Thus, the commercial impression of a solid blue necktie is different from that of a blue envelope, or a blue deck of cards, or a blue building. Moreover, applicant's proposed mark would not even be limited as to the shape of the surface on which it is used, but could conceivably appear as a thin horizontal blue line, or a thick vertical blue stripe.

A trademark application may only seek to register a single mark. **In re International Flavors & Fragrances Inc.**, 183 F.3d 1361, 51 USPQ2d 1513 (Fed. Cir. 1999). In International Flavors, the Court of Appeals for the Federal Circuit found that an application for a mark containing a "phantom" element (e.g., LIVING xxx FLAVOR) would violate this one mark per registration requirement. In addition to noting that one mark per application is a requirement of the rules, the Court discussed the policy reasons why this should be the case. Providing notice to potential users of

the same or a confusingly similar mark is one of the reasons for encouraging registration of trademarks. However, the Court stated that phantom marks with missing elements, "encompass too many combinations and permutations to make a thorough and effective search possible. The registration of such marks does not provide proper notice to other trademark users, thus failing to help bring order to the marketplace and defeating one of the vital purposes of federal trademark registration." Id. at 51 USPQ2d 1517-18.

Although applicant does not seek to register a so-called phantom mark, its desire to register the color blue per se, not limited to any specific physical form, creates the same problems noted by the Federal Circuit in connection with phantom marks. That is, the virtually unlimited number of uses of the color blue--from uniforms to key chains to cars to pens to decks of cards--would make a thorough and effective search difficult, if not impossible.

Moreover, unlike the International Flavors, case, the mark applicant wants to register is the color blue. As noted above, color marks differ from word marks in that a mark consisting of the color of an item can never be inherently distinctive. However, a determination of

whether acquired distinctiveness has been demonstrated must, in the case of service mark use, depend on the item on which the color is used. Evidence which may be sufficient to show that the color blue placed on a portion of a vehicle service center is recognized by consumers as a mark for car rental services may not be sufficient to prove that the same color blue, used on rental cars, functions as a mark for car rental services, particularly given the number of blue cars that are sold and rented by various entities. However, according to applicant's reasoning, i.e., that it is entitled to register the color blue, used in all manners, in connection with vehicle rental services, we would have to accept a Section 2(f) showing as to certain uses as supporting a registration which would encompass the use of blue on cars. Of course, the opposite result could occur as well, namely, that if applicant could not prove acquired distinctiveness of the color blue for rental cars, its claim of acquired distinctiveness would fail for the color blue in general.

Having found that applicant's mark is the mark shown on the drawing, and that applicant's proposed description of its mark would be a material alteration of the mark for which registration was sought, we affirm the refusal based on the requirement for an acceptable description. As for

the remaining ground for refusal, it is clear from the Senior Trademark Attorney's final Office action, as well as her brief, that the refusal under Sections 1, 2 and 45, referred to the color blue per se failing to function as a mark, and not to the color blue as used on the side of a building, which is the use shown in the drawing. In fact, in the January 19, 1999 Office action the Senior Trademark Attorney specifically states that "The examining attorney agrees that the evidence shows that the mark which appears on the drawing, i.e. the color blue on the building, had acquired distinctiveness." Accordingly, we deem this refusal, as it applies to the applied-for mark (the mark shown in the drawing) to have been withdrawn.

Although the requirement for an acceptable description of the mark is the only requirement/refusal which we affirm, we note that applicant is not in fact hurt by what is seemingly a technical requirement. As shown by the submission with its request for reconsideration, applicant already has an application for the same mark shown in the drawing of the subject application, and it includes the same services identified in the present application. That application was published for opposition on April 13, 1999.

Decision: The refusal based on the requirement for an acceptable description of the mark is affirmed.

Ser. No. 75/193,074

E. J. Seeherman

G. D. Hohein

T. E. Holtzman  
Administrative Trademark Judges  
Trademark Trial and Appeal Board